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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,729	07/12/2006	Tadashi Maeda	043890-0927	7206
20279 7590 11/17/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EXAMINER ABDEL RAHMAN, AHMED	
			ART UNIT 4184	PAPER NUMBER
			MAIL DATE 11/17/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/585,729

Applicant(s)

MAEDA ET AL.

Examiner

AHMED ABDEL RAHMAN

Art Unit

4184

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006 and 24 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date 07/12/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of group II in the reply filed on October 24, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-3 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/24/2008.

Specification

3. The abstract of the disclosure is objected to because applicant refers to "it" in the first sentence, while never reciting what "it" refers to. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al (US 6,189,771) in view of Mei (US 6,680,128).

In regards to claims 4, Maeda teaches a method for soldering a first electrode with a solder portion to a second electrode, as observed in the sequences depicted in figures 3A-3E, where electrode 18 and electrode 12 are the first and second electrode, respectively, using a metal (solder) paste that is coated with flux comprising of either tin, lead, zinc, gold, silver, copper, antimony, indium, or bismuth filled between the soldering portion and the second electrode by positioning the first electrode directly above the second electrode where the metal paste is within the cavity (metal paste 5, figures 3A-3E). Where the electronic component, or substrate, is then fed to the reflow process allowing the molten solder from the solder ball to wet the metal particles of the metal paste which in turn wets the surface of the electrodes, followed by

solidifying the melted solder to form a solder bump which allows for good bonding and electrical connection (column 4, lines 23-35).

While Maeda in regards to claim 4, teaches that the metal paste is coated with a flux, Maeda fails to teach that the paste includes a liquid basis resin component, an activator removing oxide film produced on surfaces of the solder portion, as well as a metal powder that includes a core metal and a surface metal to cover the surface of the core metal. However, Mei teaches solder compositions of pastes where a particular solder composition is most preferably a metal alloy of tin and zinc (core metal) coated with a material preferably selected from copper, silver, palladium, tin, or gold (Column 2, lines 19-24). Mei also teaches that the coated solder composition used in the solder paste is also suitable for being combined with a flux containing a rosin, derivatives of a rosin such as a dimerized resin, an activator, and a solvent (Column 4, lines 40-49), thus the paste would have a sense of liquidity (liquid basis). Where the solder composition is mixed with the flux to form a roughly 50-50 mix of flux and solder composition (column 4, lines 60-62), thus for it to be a paste it would be necessarily inherent that the paste would have liquidity since. In regards to the particular limitation of claim 4, reciting that the surface metal would be dissolved into the core metal, this would inherently happen depending on the thickness of the surface metal that is coating the core since it is exposed to the reflow process directly (column 4, lines 8-11).

In view of Mei's teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine, with Maeda's soldering method that solders together two electrodes by a soldering bump through the use of a soldering paste, a particular soldering paste that contains a core and surface metal, since using a paste that contains a core and

surface metal would allow for lower melting points, longer shelf life, and better effective wetability properties (Mei, Column 3, lines 5-10).

In regards to claim 5, Wherein the core metal is selected from the group of tin, zinc, lead, and indium, and the surface metal includes any one of gold and silver, Mei teaches that the solder composition (core metal) can be either tin or zinc, while the coating material (surface metal) can be either copper, silver, palladium, tin, or gold (Column 2, lines 19-24).

In regards to claim 6: wherein the core metal includes tin or tin-based alloy, and the surface metal includes silver (Mei, column 2, lines 19-24).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ABDEL RAHMAN whose telephone number is (571) 270-5931. The examiner can normally be reached on Mon-Thurs, 7 30am- 5 00pm, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jared Fureman can be reached on 571-272-2391. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AHMED ABDEL RAHMAN/
Examiner, Art Unit 4184

/Jared J. Fureman/
Supervisory Patent Examiner, Art Unit
4184